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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,703	10/13/2005	Motoo Sumida	47237-0528-00-US (216939)	5291
55694 7590 09/03/2010 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
LILLING, HERBERT J				
ART UNIT		PAPER NUMBER		
1657				
NOTIFICATION DATE		DELIVERY MODE		
09/03/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DBRIPDocket@dbi.com

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### Office Action Summary

**Application No.**

10/527,703

**Applicant(s)**

SUMIDA ET AL.

**Examiner**

HERBERT J. LILLING

**Art Unit**

1657

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-16, 21-23 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 14-16, 21-23 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9, 14-16, 21-23 and 30 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/11/09; 7/20/09; 12/7/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Applicant has properly responded on May 26, 2010 to a restriction and election of species requirements.

2. Claims 1-9, 11-16, 21-23 and 27-30 are pending in this application.

3. Applicant has elected without traverse Group II: Claims 11-16 and 27-30, drawn to a product.

Claims 1-9 and 21-23, drawn to processes have been withdrawn.

In view of the election of species requirement, claim 14-16 and 30 have been withdrawn.

Thus, Claims 11-13 and 27-29 are within the scope of the claimed scope.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-13 and 27-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific examples drawn to products-by-processes, does not reasonably provide enablement for the claimed products which the instant specification has been found to be totally lacking support for structures or compounds. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and practice the invention commensurate in scope with these claims.

The specification does not teach a generic structure as well as the specification does not teach structures containing polyunsaturated fatty acids containing 50 or more carbon atom as well as having ten or more double bonds. What is the structure of the

above or any other properties which indicates enablement for the exceptionally broad claimed language.

"....even though claims superficially appear definite, **since intended scope of claims cannot be determined**, nor is there adequate enabling support for breadth that would seem to be attributable to those claims, see Ishizaka, In re, (Bd Pat. App & Int, 4/30/92, 1621."

"The boundary defining excludable subject matter must be carefully set: it must protect the inventor, so that commercial development is encouraged; but the claims must be commensurate with the inventor's contribution. Thus the specification and **claims must meet the requirements of 35 USC 112**, see In re Fisher 427 F.2d 833, 839, 166 USPQ 18, 23-24 (CCPA 1970)."

"Such improvements, while unobvious from his teachings, are still within his contribution, since the improvement was made possible by his work. It is equally apparent, however, that he must not be permitted to achieve this dominance by claims which are insufficiently supported and **hence not in compliance with the first paragraph of 35 U.S.C. 112**. that paragraph requires that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.....In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved, see In re Fisher, 168 USPQ 18, 24 (June 11 1970)."

"An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, **structures, figures, diagrams, and formulas** that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir.1997). "

"Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the

applicant was in possession of the claimed invention. See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998);"

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-13 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Vague and indefinite as to the structure of the compound(s) for the double bonds in the structures.

Vague and indefinite as to the expression "oil/fat or triglyceride" since the claim recites "and which contains at least 40% of triglycerides". Thus, the claims are vague and indefinite as to the scope of e.g., claim 11 as to whether the claim is drawn to:

- I) Claim is drawn to:
  - a) one compound;
  - b) a mixture of separate compounds;
  - c) other(s)-please specify.
- II Claim contains:
  - a) a transesterified oil or transesterified fat
  - b) mixture of above a)
  - c) mixture of transesterified fat(s);
  - d) triglyceride

e) mixture of e) with any of above a-d.

f) other(s)- please specify.

III) The number of double bonds in a specific same PUF is:

a) two;

b) three;

c) other(s)-please specify

d) any combination of above-please specify.

"Although an essential purpose of the examination process is to determine whether or not the claims define an invention that is both novel and non obvious over the prior art, another essential purpose of patent examination is to determine whether or not the claims are precise, clear, correct, and unambiguous. The uncertainties of claim scope should be removed, as much as possible, during the examination process. The inquiry during examination is patentability of the invention as applicant regards it. If the claims do not particularly point out and distinctly claim that which applicants regard as their invention, the appropriate action by the examiner is **to reject the claims under 35 U.S.C. 112, second paragraph**. In re Zletz, 893 F.2d 319, 13 USPQ2d 1320 (Fed.Cir. 1989)."

6. No search of the art can be properly made due to the above issues whereby the specification lacks any upper range for the number of carbon atoms for the polyunsaturated acids as well as the upper range for the number of double bonds and the location of the double bonds

7. In accordance with this Tech Center Policy based on above restriction containing product claims and process claims, this Examiner will rejoin any non-elected

process claims upon the election of a product claim which is subsequently is found allowable in view of the following guidelines:

**F.P.: Ochiai/Brouwer Rejoinder form paragraph**

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.** Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HERBERT J. LILLING whose telephone number is 571-272-0918. The examiner can normally be reached on WORK AT HOME MAXIFLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.J.Lilling: HJL

(571) 272-0918

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August 16, 2010

/HERBERT J LILLING/  
Primary Examiner Art Unit 1657